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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MSDI-259/PC757.00

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on April 6, 2009

Signature

Typed or printed  
name

Douglas A. Collier

Application Number

10/603,471

Filed

June 25, 2003

First Named Inventor

Larry Gause et al.

Art Unit

3775

Examiner

Anuradha Ramana

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 43,556

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:  
Larry Gause et al.

Application Serial No. 10/603,471

Filed: June 25, 2003

SYSTEM FOR STABILIZING A PORTION  
OF THE SPINE

) Before the Examiner:  
) Anuradha Ramana  
)

) Group Art Unit: 3775  
)

) Attorney Ref. No.:  
) MSDI-259/PC757.00  
)

) April 6, 2009

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Final Office Action dated December 5, 2008, and Advisory Action dated March 6, 2009, please enter and consider the following. A Notice of Appeal, and form PTO/SB/33 Pre-Appeal Brief Request for Review is submitted herewith along with the fee under 37 CFR 41.20(b)(1). Since a Response to the Final Office Action was filed February 4, 2009, within two months of the mailing date of the Final Office Action, and the Advisory Action was mailed on March 6, 2009, after three months from the mailing of the Final Office Action, extensions of time are measured from the mailing of the Advisory Action. Therefore, a one month extension of time to and including April 6, 2009, is believed due for consideration of the enclosed and is submitted herewith along with the fee for the same. Please provide any additional extensions of time that may be necessary and charge any additional fees due, or credit any overpayment, to Deposit Account 12-2424, but not including the payment of issue fees.

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

April 6, 2009

Date of Transmission

Douglas A. Collier

Name of Registered Representative

*Douglas A. Collier*

Signature

April 6, 2009

Date of Signature

Pre-Appeal Brief Request for Review  
Application Serial No. 10/603,471  
Atty Docket No. MSDI-259/PC757.00  
Page 1 of 5

## REMARKS

In the Final Office Action mailed December 5, 2008, and Advisory Action mailed March 6, 2009, claims 1, 4, 11-38, 59-62, 81-82, 87 and 89-93 were pending and stand finally rejected. The currently pending claims were presented with the Request for Continued Examination filed on February 28, 2008. A response to the June 11, 2008 Non-final Office Action was submitted by Applicants on 9/11/08 and a response to the December 5, 2008 Final Office Action was submitted by Applicants on 2/4/09. No further amendments to the claims were made.

Claims 36-38 stand rejected under 35 USC §102(b) as anticipated by U.S. Patent No. 5,423,826 to Coates et al. Remarks traversing this rejection were presented on p. 13, 2<sup>nd</sup> full para. of the 9/11/08 Response and on p. 2, 2<sup>nd</sup> full para. of the 2/4/09 Response. The examiner asserts that Fig. 19 in Coates “clearly discloses guide member 180 mounted to the stationary member and spaced proximally from the plate (Fig. 19).” In Fig. 19, guide member 180 is not mounted to any stationary member. Therefore, even if guide member 180 in Fig. 19 is spaced proximally from the plate as asserted by the examiner, there is no disclosure that in this position guide member 180 is mounted to any structure at all. When guide member 180 is mounted to the instrument, Coates discloses that guide member 180 is positioned in foot 157. There is no disclosure that guide member 180 is both mounted to any portion of either of members 151, 152 of instrument 150 and spaced proximally of foot 157. Therefore, claim 36 along with its dependent claims 37-38 are not disclosed in Coates et al.

Claims 1, 4, 11-14, 18, 20-27, 81-82, 87, 92 and 93 stand rejected under 35 USC §103(a) as being unpatentable in view of U.S. Patent App. Pub. No. 2003/0105462 to Haider alone. Remarks traversing this rejection were presented in the 9/11/08 Response from the 3<sup>rd</sup> full para. of p. 13 thru the 2<sup>nd</sup> full para. of p.16; and in the 2/4/09 Response from the 3<sup>rd</sup> full para. of p. 2 thru the 1<sup>st</sup> full para. of p. 4. In the Final Office Action, the examiner asserts that the “Examiner has clearly explained how Haider renders Applicant’s claimed invention obvious. Haider clearly discloses an opening with an hour-glass shape. The opening inherently has a maximum and minimum width, although a specific numeric value has not been provided for the maximum width or the minimum width. Applicant’s claimed invention is merely changing the dimensions of various portions of an opening having an hour-glass shape.” It is respectfully submitted that claim 1 recites a relationship between the opening and the structural members of the plate extending along the opening that is not

disclosed or taught in Haider. Claim 1 is directed to the maximum width of the first and second members of the plate that extend alongside the opening, and the opening is recited to include a minimum width, and this minimum width that is greater than the combined maximum widths of the members of the plate that extend alongside the opening. This organization and relationship between the elements of claim 1 is not disclosed or taught in Haider. A prima facie case for rejecting claim 1 along with claims 4, 11-14, and 18 depending from claim 1 has not been established.

Claim 20 also distinguishes Haider for the reasons claim 1 does, and a prima facie case for rejecting claim 20 along with claims 21-27 and 92-93 depending therefrom has not been established.

Haider also fails to disclose or suggest the features in claim 81. The members along the central element in Haider do not include a uniform width along the central element. Rather, the members have a variable width due the different curvatures of the inner and outer sides of the walls along the central element. Fig. 2 of Haider shows the sidewall along the central element has a curvature that is different than the curvature of the outer sidewall so that the width of the members along the central element is not uniform, and does not teach claim 81. Claim 87 depending from claim 81 is allowable as discussed above with respect to claim 1. Thus, a prima facie case for rejecting claim 81 along with claims 82 and 87 depending therefrom has not been established.

Claims 1, 4, 11-15, 18-27, 81-82, 87, 92 and 93 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,413,259 to Lyons et al. alone. Remarks traversing this rejection were presented in the 9/11/08 Response from the 3<sup>rd</sup> full para. of p. 16 thru the 2<sup>nd</sup> full para. of p.19; and in the 2/4/09 Response from the 2<sup>nd</sup> full para. of p. 4 thru the 2<sup>nd</sup> full para. of p. 5. It is respectfully submitted that Lyons et al. and the rejection of claims 1 and 20 based thereon suffer the same deficiencies as the rejections of these claims based on Haider. Therefore, a prima facie case for rejecting claims 1, 4, 11-15, 18-27, 92 and 93 has not been established.

Lyons et al. also fail to disclose or suggest the features in claim 81. The members along hole 28 in Lyons et al. do not include a uniform width along hole 28, but have a variable width due the different curvatures of the inner and outer surfaces of the members along hole 28. Also, claim 87 depending from claim 81 distinguishes Lyons et al. for the reasons claim 1 does. Thus, a prima facie case for rejecting claims 81, 82 and 87 has not been established.

Claims 16-17, 28-35 and 89-91 stand rejected as being unpatentable over Lyons et al. in view of U.S. Patent No. 6,193,721 to Michelson. Remarks traversing this rejection were presented in the

9/11/08 Response from the 3<sup>rd</sup> full para. of p. 19 to the 1<sup>st</sup> full para. of p. 21; and in the 2/4/09 Response from the 3<sup>rd</sup> full para. of p. 5 to the 1<sup>st</sup> full para. of p. 7. Claims 16 and 17 depend from claim 1 and are allowable at least for the reasons claim 1 is allowable over Lyons et al. as discussed above. Claim 28 recites, among other features, a plate and a holding instrument that includes a holding system engaged to the plate by clamping end walls of the plate, and “wherein said first and second holding members move toward and away from one another in a direction that follows said longitudinal axis of said plate and further comprising a pair of guide members on said holding instrument positioned on opposite sides of said longitudinal axis when said holding system is engaged to said plate.” The examiner does not identify any disclosure or teaching of the claimed pair of guide members positioned on opposite sides of the longitudinal axis of the plate when the holding instrument is engaged to the plate in a direction that follows the longitudinal axis of the plate as recited in claim 28. In Michelson, the examiner asserts that compression post 54 is a guide member. However, Michelson discloses that compression posts 54 are received in bores 106, 132 in arms 104, 130. The rejection fails to consider that compression posts 54 cannot be offset on opposite sides of the longitudinal axis when received in the bores of arms 104, 130 that are located along the longitudinal axis. Therefore, a prima facie case for rejecting claim 28 has not been established. Claims 29-35 depend from claim 28 and are also allowable at least for the reasons claim 28 is, and claims 32 and 34 are independently allowable for the reasons provided at p. 20 of the 6/11/2008 Response.

With respect to claim 89, the cited references do not teach or suggest a plate and holding instrument combination where the holding instrument also includes at least one guide member mounted to a stationary member of an actuating system with the guide member positioned relative to the longitudinal axis of the plate “in offset relation to said longitudinal axis so that said at least one guide member is positioned relative to said plate to guide placement of a bone engaging fastener through said at least one hole when said first and second holding members are engaged to said plate along said longitudinal axis.” The examiner identifies elements 54 in Michelson as guide members, but compression posts 54 are not arranged in offset relation to the longitudinal axis of the plate when compression posts 54 are received in the bores of the arms 104, 130 when arms 104, 130 are engaged to the plate along its longitudinal axis. Therefore, a prima facie case for the rejection of claim 89 along with claims 90 and 91 depending therefrom has not been established.

Claims 1, 4, 11-15, 18, 20-27, 92 and 93 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,954,722 to Bono et al. alone. Remarks traversing this rejection were presented in the 9/11/08 Response from the 1<sup>st</sup> full para. of p. 21 thru the 1<sup>st</sup> full para. of p. 22; and in the 2/4/09 Response from the 1<sup>st</sup> full para. of p. 7 thru the last para. of p. 7. The maximum width in claim 1 is directed to the first and second members of the plate that extend alongside the opening, and are not directed to any dimension of the opening. The opening itself is recited to include a minimum width, and it is this minimum width that is greater than the combined maximum widths of the members that extend alongside the opening. This organization and relationship between the claimed elements is not disclosed or taught in Bono, nor has the examiner been able to point to any such teachings in the prior art, and withdrawal of this basis of the rejection of claim 1 is respectfully requested along with claims 4, 11-15, and 18 depending from claim 1. Bono et al. also fail to disclose or suggest the features in claim 20 for the reasons discussed above with respect to claim 1. Therefore, a prima facie case for rejecting claim 20 along with claims 21-27 and 92-93 depending from claim 20 has not been established.

Claims 59-62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bono et al. in view of Boucher et al. and, separately, over Lyons et al. in view of Boucher et al. Remarks traversing this rejection were presented in the 9/11/08 Response from the 2<sup>nd</sup> full para. of p. 22 to the 1<sup>st</sup> full para. of p. 24; and in the 2/4/09 Response from the 1<sup>st</sup> full para. of p. 8 thru the last para. of p. 8. Claim 59 distinguishes the references at least for the reasons provided above with respect to claim 1. Claim 60 depends from claim 59 and distinguishes the references for the reasons provided above with respect to claim 81. Therefore, a prima facie for rejecting claims 59-62 has not been established.

Reconsideration of the present application is respectfully requested.

Respectfully submitted,

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